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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,290	06/28/2000	Howard Stein	PMS-265915 HS-1	5958
27498	7590	12/15/2003		
PILLSBURY WINTHROP LLP 2550 HANOVER STREET PALO ALTO, CA 94304			EXAMINER COLIN, CARL G	
			ART UNIT 2133	PAPER NUMBER
			DATE MAILED: 12/15/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,290

Applicant(s)

STEIN, HOWARD

Examiner

Carl Colin

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Pursuant to USC 131, claims 1-3, 6, 8, and 10-24 are presented for examination.

Specification

2. The abstract of the disclosure is objected to because it should avoid the phrase such as "The disclosure describes" as referred to line 2: "Described is". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3.1 **Claims 11, 16, and the intervening claims** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On the first step of claims 11 and 16, applicant incorporates as new matter “a medium having an authorized user having a face, the image being free of the face of the authorized user”. In the written description, applicant fails to describe a photograph having an image of an object and a user face as described in the above claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1 and the intervening claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 Regarding **claim 1**, the “program” mentioned in claim 1 renders the claim(s) indefinite because it is not clear whether the program in question refers to a hardware or software program.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1 **Claims 1-3, 6, 8, and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,581,634 to **Williams** in view of US Patent 5,932,119 to **Kaplan et al.**

5.2 **As per claim 1, Williams** substantially teaches an encrypting security device comprising means for receiving and transmitting signals of the photograph that meets the recitation of a program initialized to recognize the security photograph and allow access to an associated apparatus (see column 2, lines 18-40); and a scanner connected with the program (see column 2, lines 18-40). **Williams** does not explicitly teach a security photograph incorporating a multiplicity of picture elements, the security photograph having an image of an object, the object having a size, the image having a size that is greater than the size of the object.

However, **Kaplan et al.** in an analogous art teaches a photograph with multiplicity of elements (see column 4, lines 1-12 and column 8, lines 1-15). **Kaplan et al.** further teaches a device used to magnify an object with an image greater than the size of the object (see column 12, lines 36-47 and column 15 lines 60 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the photograph of **Williams** with a

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photograph of an enlarged image of multiplicity of picture elements because each stone has varying characteristics that make each stone essentially unique as taught by **Kaplan et al.** (column 8, lines 1-15). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Kaplan et al.** so as to benefit from varying characteristics, details, and uniqueness of the image of the stone.

As per claim 2, Kaplan et al. discloses access to a computerized control system using video pattern of a workpiece (see column 5, lines 25-38).

As per claim 3, Williams discloses the limitation of wherein the associated apparatus is selected from a group including a vehicle, a safe, a cash register, a locking system of a building, and an alarm system of a building (see column 8, lines 1-14).

As per claim 6, Kaplan et al. discloses the limitation of wherein the security photograph is an enlargement of the center of a gemstone (see column 12, lines 36-47 and column 15 lines 60 et seq.).

As per claim 8, Williams substantially teaches a method of securing access to an apparatus, the method comprising scanning a photograph; initializing a program to recognize a scan of the photograph and require a user to scan the photograph to access the apparatus (see column 2, lines 18-40). **Williams** does not explicitly teach using a microscope to produce an enlarged photograph of an object. However, **Kaplan et al.** in an analogous art teaches using a

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video microscope to produce a larger image (see column 12, lines 12-25 and column 15, line 45 through column 16, line 7). **Kaplan et al.** Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the photograph of **Williams** with a photograph of an enlarged image using a microscope because each stone has varying characteristics that make each stone essentially unique as taught by **Kaplan et al.** (column 8, lines 1-15). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Kaplan et al.** so as to benefit from varying characteristics, details, and uniqueness of the image of the stone.

As per claim 10, **Kaplan et al.** discloses the limitation of wherein the object comprises a gemstone (see column 12, lines 36-47).

6. **Claims 21-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,993,068 to **Piosenka et al.** in view of US Patent 5,932,119 to **Kaplan et al.**

6.1 As per claim 21, **Piosenka et al.** substantially teaches a security system that controls access to a secured element, the security system comprising a scanner that scans the medium to generate a digital representation of the image (see figure 1); and a processor connected to the scanner that grants access to the secured element when the digital representation satisfies an access criteria, and denies access to the secured element when the digital representation fails to satisfy the access criteria (see figure 1 and abstract). **Piosenka et al.** does not explicitly teach a medium having an image of an object, the object having a size, the image having a size that is

greater than the size of the object. However, **Kaplan et al.** in an analogous art teaches a device used to magnify an object with an image greater than the size of the object (see column 12, lines 36-47 and column 15 lines 60 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the photograph of **Piosenka et al.** with a photograph of an enlarged image of multiplicity of picture elements because each stone has varying characteristics that make each stone essentially unique as taught by **Kaplan et al.** (column 8, lines 1-15). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Kaplan et al.** so as to benefit from varying characteristics, details, and uniqueness of the image of the stone.

As per claim 22, Piosenka et al. discloses the limitation of wherein the processor grants access to the secured element when the digital representation matches a stored value, and denies access to the secured element when the digital representation does not match the stored value (see abstract).

As per claim 23, Kaplan et al. discloses the limitation of wherein the medium is a photograph (see column 4, lines 1-12).

As per claim 24, Kaplan et al. discloses the limitation of wherein the object is a gemstone (see column 12, lines 36-47).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 4,785,290 Goldman

This patent pertains to an effective system of authentication using an object with random variations.

7.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc
Carl Colin
Patent Examiner

December 3, 2003

Guy J. Lamarre
for
Albert DeCady
Primary Examiner